REMARKS

Claims 1 through 17 are pending in this application.

DRAWINGS

Corrections have been made to Figures 15 through 17. Accordingly, a letter to the Office Draftsman accompanies this response. Indication in subsequent Office correspondence of the acceptance to the drawing corrections proposed in the letter, is requested to enable applicant to timely arrange for the corrections to be made prior to the date for payment of any issue fee. No new matter was added.

SPECIFICATION

There were some minor changes to the specification, including grammatical corrections. No new matter was added.

REJECTION OF CLAIMS (35 U.S.C. § 103)

On page 2 through 3 of Paper No. 6, claims 1 through 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sukurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630).

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The first point in MPEP 706.02(j) states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular" without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.*

The mere fact that the teachings of the prior art can be combined or modified does not itself make the resultant *prima facie* obvious. MPEP 2143.01.

Secondly, MPEP 706.02(j) states that there must be a reasonable expectation of success.

The third point in MPEP 706.02(j) states that the prior art reference (or references when

combined) must teach or suggest all the claim limitations.

Concerning claims 1, 4, and 8, Sukurai only teaches an area indicator that goes up and down a menu. The indicator as shown in Figure 13A of Sukuri shows that the indicator is not "initially displayed at a predetermined position within said menu" nor is the indicator of Sukuri "within an area of said sub menu" as shown on lines 3 and 9 of claim 1 of the present invention. Miyasahita makes no mention of such a limition, and therefore, the combination does not teach or suggest an indicator within a predetermined position "within said menu" or "submenu."

The combination also does not teach or suggest the storing of a location of a menu item, and when a submenu is displayed and erased, automatically adjusting the display of the indicator at said location of menu item (lines 6-12 of claim 1 and lines 7, 13-15 of claim 8 of the present invention). Sukuri only teaches of a process of loading and displaying a submenu and loading a submenu based on the menu display definition file, however, no mention is made of storing a location of a menu item, so when the submenu is erased, the indicator would go back to the stored location. In col. 9, lines 48-56 of Sakurai, it is mentioned that the history of the menu selections as to a movement in depth direction of the hierarchy can be stored in the display file name storage area, but this does not disclose the teachings of the present invention. Storing the depth direction of the hierarchy is different from the location in the menu being stored so that the pointer will revert back when the submenu is erased. Miyashita also makes no such mention, and therefore, does not teach or suggest such a limitation.

Concerning claims 9-10, the examner mentions that Miyashita teaches about a projection system where the position of the pointer can be controlled apart from the main control means and

that the operatior can freely control the display position of the position mark by operating a hand-held remote controller. However, as shown in claims 9-10, neither Miyashita or Sakurai teach or suggest an indicator that is initially located in the center of the first menu item (claim 9 of the present invention) and after erasing the submenu, the indicator locates back to the center of the stored location of the menu (claim 10 of the present invention).

Concerning claim 16, the examiner stated that Miyashita teaches an equivalent screen display as seen in figure 13A an 13B. However, looking at the drawings, it mentions only the term "screen" display which does not teach or suggest a cathode-ray tube. Furthermore, Miyashita teaches away from a cathode-ray tube as seen in col. 6, lines 54-56 it states that figs 13A, 13B, and 13C are descriptive drawing indicating the projector function adjustment procedure using the remote control. The display screen of 13A and 13B is from the projector projecting an image which teaches away from a cathode-ray tube.

Concerning claim 17, Miyashita and the combination does not teach or suggest a shift value data storage unit accommodating the storing shift value data corresponding to the movement of the trackball relative to the initial indicator position. In Miyashita, col. 9, lines 12-22, suggests that the pointing device sends the signals directly to the person computer. There is no mention that the apparatus itself has a data storage unit accommodating the storing of shift value data.

Furthermore, concerning claim 17, the combination of Miyashita or Sakurai does not teach or suggest "said indicator display unit displays said indicator in a center point of selected submenu" (line 22-23 of claim 17). Miyashita only mentions a pointer, but no mention about the positioning and Sakuri mentions only an indicator that goes only up and down in the vertical axis.

Concerning claims 1 through 17, there is no motivation to combine Sakurai with Miyashita. The examiner mentioned that it would have been obvious to modify Sakurai's menu system to include Miyashita's remote controller with all of its features. The examiner further stated that one would have been motivated in view of the suggestion in Miyashita that the desired manually operated remote controller is equivalent to Miyashita's remote controller, and the use of which helps for wirelessly transmitting an operational signal as taught by Miyashita. As mentioned by the *Dembiczak* court above, this motivation is not clear and particular. In Sukarai, the indicator can move in only one direction, vertical. The motivation of the remote control, still has nothing to do with controlling the indicator or pointer in all directions. There is nothing in the art the suggest to modify Sukarai's indicator in multiple directions as shown by a Miyashita. In fact if the indicator was to be able to move in all directions away from the menu, then it would not function properly. In col. 9, lines 48-57 of Sakurai, it states that the area indicator is increamented one each time a new submenu is displayed, and in this manner, the history of menu selections as to a movement in a depth direction of the hiearchy can be stored in the display file name storage area. Therefore, Sakurai is teaching away from using a pointer that can placed anywere in the display area. The combination would then not be able to keep track of the history if such an indicator is included.

Therefore, in view of foregoing amendments and remarks, the applicant respectfully requests that the examiner withdraw the rejection of claims 1 through 17.

PRIOR ART NOT RELIED UPON

The prior art reference (or references when combined) made of record and relied upon do not teach or suggest all the claim limitations of the present claimed invention. Respectfully, the prior art made of record and not relied upon, do not form a bases for 35 U.S.C. §102 or 35 U.S.C. §103 rejections.

No substantive changes were made to the present application.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,

Robert E. Bushnell
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P55862
Date: 28 September 2001
I.D.: REB/SS

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

1. Please amend the paragraph bridging page 3 and page 4, from line 18 on page 3 through line 3 on page 4, as follows:

Kayashima et al. (U.S. Patent 5,488,427, *Television System Including Television Set, and Accessory Devices Controlled by a Single Remote Control Device*, January 30, 1996) discloses a television system having method and apparatus for selecting preset or use determined devices. A remote control device is shown to have buttons to display and select an on screen menu. Menu items are selecting by selecting the corresponding buttons on the remote control. The item selected is [show] shown on the display. A problem with Kayashima et al. '427 is that it requires too many buttons for rapidly and conveniently controlling a television.

2. Please amend the first complete paragraph on page 4, from line 4 through line 8 on page 4, as follows:

Yamamoto (U.S. Patent 5,457,446, *Control Bus System with Plural Controllable Devices*, October 10, 1995) discloses a control bus system for a home entertainment system. The control bus further [comprises] includes a display means for displaying the features to be executed by the control bus. A cursor is moved to display item to be selected. Yamamoto '446 , requires extra movement to locate the area to be selected.

3. Please amend the second complete paragraph on page 5, from line 5 through line 9 on page 5, as follows:

According to an embodiment of the method for controlling the position of an indicator of the present invention, to achieve the above object, when a menu having items selected and adjusted by the indicator is displayed, and an item having [sub items] sub-items capable of being selected and adjusted is selected, the [sub items] sub-items are displayed and the indicator is located in the area where the [sub items] sub-items are displayed.

4. Please amend the first complete paragraph on page 9, from line 1 through line 3 on page 9, as follows:

FIG. 3A which shows an example of a menu screen in [a] an interface method where a menu is overlapped with a program image. In FIG. 3A, reference numeral 32 denotes a pointer, and reference numeral 34 denotes a main menu.

5. Please amend the sixth complete paragraph on page 9, from line 13 through line 14 on page 9, as follows:

In FIG. 4A, reference numerals 40, 42, 44 and 46 denote an image where a program image signal is displayed, a pointer, a main menu and an area where the menu is displayed, respectively.

6. Please amend the third complete paragraph on page 13, from line 7 through line 9 on page 13, as follows:

The pointer 52 is located in a program list area (S1005). When the program guide image [id] is displayed, the pointer 52 is located in the program list area so that a desired program can be easily selected.

7. Please amend the second complete paragraph on page 14, from line 5 through line 8 on page 14, as follows:

Referring to FIG. 12, data for the menu item [is comprised of] includes an identifier 120, area information 122, information 124 indicating whether the sub menu exists or not, address information 126 indicating a position where information on a sub menu is stored, and command information 128 indicating a command allocated to the menu item when there is no sub menu.

8. Please amend the sixth complete paragraph on page 17, from line 18 through line 20 on page 17, as follows:

The program guide information generator [254] 264 obtains program guide information from the program guide information storage [366] 266 in response to the program guide command received through the receiver 252, and generates a corresponding program guide image signal.

9. Please amend the first complete paragraph on page 18, from line 1 through line 4 on page 18, as follows:

When the enlargement and reduction key 166 of the remote controller 100 is pressed, the data generator 160 generates enlargement and reduction commands. When the enlargement and reduction key which is a toggle key is once pressed, the enlargement command is generated, and when the key is [more once] pressed once more, the reduction command is generated.

10. Please amend the second complete paragraph on page 18, from line 5 through line 8 on page 18, as follows:

The program guide information generator 254 obtains program guide information from the program guide information storage [366] 266 in response to the enlargement and reduction command received through the receiver 252, and displays corresponding enlargement and reduction program list.

11. Please amend the fifth complete paragraph on page 18, from line 14 through line 17 on

page 18, as follows:

When the selection key of the remote controller 100 is pressed, corresponding command is performed. For instance, in order to select a program, the program guide performer 268 obtains a channel number of the program where the pointer is located and supplies the obtained channel number to the tuner [270].